

Atty Dkt. No.: 10004452-1
USSN: 10/017,107

REMARKS

In view of the following remarks, the Examiner is requested to withdraw the rejections and allow Claims 1-5, 8 and 23-42, the only claims pending and currently under examination in this application.

The Examiner is thanked for the acknowledgement of allowability of Claims 1-5, 8, 30, 31, 41 and 42, as well as Claims 26-28.

The Examiner is thanked for the personal interview held for this case on October 26, 2004. During the interview the above amendments were discussed with respect to the remaining rejections. Agreement was reached that the above amendments, in addition to evidence of a proper product by process claim format and evidence of common ownership with the cited Bruhn reference, would place the application in form for allowance.

In the above amendments, amendments have been made to several of the claims to clarify elements thereof. Any amendments to the claims find full support in the claims as previously pending, as well as in the specification as filed. As such, no new matter is introduced to the application by the above amendments, and entry of the above amendments is respectfully requested.

Objections have been raised to Claims 23, 25, 32, 34 and 35. It is respectfully submitted that the above amendments address the objections to Claims 23, 32, 34 and 35.

With respect to Claim 25, the examiner has questioned whether this claim has a proper format since it lacks a transitional phrase, e.g., comprising.

However, Claim 25 is a product by process claim and, as such, no amendment to the format of the claim language is believed necessary.

The MPEP teaches that :

2173.05(p) Claim Directed to Product-By- Process or Product and Process

I. PRODUCT-BY-PROCESS

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A product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper. *In re Luck*, 476 F.2d 650, 177 USPQ 523 (CCPA 1973); *In re Pilkington*, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969); *In re Steppan*, 394 F.2d 1013, 156 USPQ 143 (CCPA 1967). A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process.

An applicant may present claims of varying scope even if it is necessary to describe the claimed product in product-by-process terms. *Ex parte Pantzer*, 176 USPQ 141 (Bd. App. 1972).

An example of a product by process claim that has been issued by the patent office includes the following claim from U.S. Patent No. 4674204. This patent includes the following Claim 24:

"The molded innersole produced by the method of claim 1."

This patent was the subject of court review in *Atlantic Thermoplastics Co. v. Faytex Corp.*, 974 F.2d 1299, 24 U.S.P.Q.2D (BNA) 1138 (Fed.Cir. 1992). During review, the Federal Circuit found nothing wrong with the claim format, despite the fact that it lacked a transitional phrase. Accordingly, Claim 25 is believed to have a proper format despite the fact that it lacks a transitional phrase.

Accordingly, these objections may be withdrawn.

Finally, Claims 23-25 and 32-40 have been rejected 35 U.S.C. § 103(a) over *Faulkner* in view of *Bruhn*.

Referring to 35 USC § 103(c), MPEP § 706.02(I)(1) states "Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(c) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and

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plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues.”

As noted above, the changes made to 35 USC § 103(c) apply to all utility patent applications filed on or after November 29, 1999. Since the instant application was filed on December 13, 2001, which is after November 29, 1999, the above law applies to the instant application.

As such, according to 35 USC § 103(c), if the Bruhn patent and the instant application were owned by the same person or subject to an obligation of assignment to the same person, at the time the instant invention was made, the Bass patent is not available as prior art against the invention now claimed.

The invention claimed in the instant patent application was owned by Agilent Technologies, Inc. (“Agilent”) or subject to an obligation of assignment to Agilent at the time the instant invention was made, as evidenced by an assignment executed by the inventors (Reel/Frame 013510/0448). This assignment was recorded on March 24, 2003.

The Bruhn patent (Agilent Docket No. 10981534-1) was owned by Agilent or subject to an obligation of assignment to Agilent at the time the instant invention was made, as evidenced by an assignment executed by the inventors (Reel/Frame 10977/0540). This assignment was recorded on May 30, 2000.

Thus, the subject matter of the cited Bruhn patent and the claimed invention were, at the time the invention was made, assigned or under obligation of assignment to Agilent.

Accordingly to U.S.C. § 103(c), therefore, the Bruhn patent is disqualified as prior art against the claimed invention. As such, since Bruhn is disqualified as prior art against the claimed invention, the rejection cannot be established.

Accordingly, in view of the disqualification of Bruhn as a prior art reference, these rejections of claims 123-25 and 32-40 under 35 U.S.C. § 103(a) may be withdrawn.

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Conclusion

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10004452-1.

Respectfully submitted,
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By: _____

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